UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,642	06/20/2006	Timothy John Norman	07-1007-WO-US	3724
	7590 01/05/201 BOEHNEN HULBER	0 RT & BERGHOFF LLP	EXAMINER	
300 S. WACKER DRIVE			DICKINSON, PAUL W	
32ND FLOOR CHICAGO, IL 60606			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			01/05/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)			
Office Action Summary		10/583,642	NORMAN, TIMOTHY JOHN			
		Examiner	Art Unit			
		PAUL DICKINSON	1618			
	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).						
Status						
1)[\	Responsive to communication(s) filed on <u>09 Se</u>	entember 2009				
	This action is FINAL . 2b) ☐ This action is non-final.					
′=	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
٥/١	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
	·	panto Quayro, 1000 0.21 1.1, 10	3 3.3.2.3.			
Dispositi	on of Claims					
4)🛛	Claim(s) <u>1-3 and 8-10</u> is/are pending in the application.					
	4a) Of the above claim(s) is/are withdrawn from consideration.					
5)) Claim(s) is/are allowed.					
6)🛛	☑ Claim(s) <u>1-2 and 9-10</u> is/are rejected.					
7)🛛	Claim(s) <u>1-3 and 8-10</u> is/are objected to.					
8)□	· · · · · · · · · · · · · · · · · · ·					
Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
7-7						
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11)□	11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority under 35 U.S.C. § 119						
_	•	priority under 35 LLC C S 110(c)	(d) or (f)			
· .	2) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a)[a) ☐ All b) ☐ Some * c) ☐ None of:					
	1. Certified copies of the priority documents have been received.					
	2. Certified copies of the priority documents have been received in Application No					
	3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attach == ===	No.\					
Attachment(s) 1) \[\sum \] Notice of References Cited (PTO-892) \qquad 4) \[\sum \] Interview Summary (PTO-413)						
	e of Draftsperson's Patent Drawing Review (PTO-948)	2) Paper No(s)/Mail Da				
3) Information Disclosure Statement(s) (PTO/SB/08) 5) Notice of Informal Patent Application						
Paper No(s)/Mail Date 6) Uther:						

DETAILED ACTION

Applicant's arguments, filed 9/9/2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objects are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

No prior art was found against the invention.

New Grounds of Rejection

Claim Objections

Claims 1-3 and 8-10 are objected to under 37 CFR 1.75, as disclosing elements that are not part of the invention. Formulae (I) and (III) show a repeat unit n. However, n is constrained to be 0, so the repeat unit shown in the formulae is not part of the invention. Accordingly, the formulae show extraneous elements to the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-2 and 10, the term "maleimide residue" renders the claim indefinite. It is unclear how far removed a "residue" can be from the parent compound without the residue being an entirely different compound altogether. Furthermore,

Art Unit: 1618

because a "maleimide residue" is not necessarily a maleimide, the phrase "the maleimide nitrogen atom" lacks antecedent basis. A "maleimide nitrogen atom" is not previously recited in the claim and there is not necessarily a maleimide nitrogen atom in the maleimide residue.

Regarding claim 9, this claim is dependent from a cancelled claim. As claim 4 has been cancelled, it is unclear what "a compound as claimed in claim 4" refers to.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DICKINSON whose telephone number is (571)270-3499. The examiner can normally be reached on Mon-Thurs 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric E Silverman/

Paul Dickinson

Application/Control Number: 10/583,642 Page 4

Art Unit: 1618

Primary Examiner, Art Unit 1618 Examiner AU 1618

December 29, 2009